



THE UNITED STATES PATENT SYSTEM – THE CHANGE IS COMING!

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Historically, the United States patent system has been a first-to-invent system. That is, in a competition between two inventors seeking a patent on the same technology, the patent has been awarded to the inventor who invented first, not the first inventor to file. The United States patent system, however, will soon change due to a piece of federal legislation, known as the America Invents Act (AIA), signed into law on September 16, 2011. Under the AIA, the United States patent system will operate as a first-to-file system such that, in a competition between two inventors seeking a patent on the same technology, the patent will be awarded to the inventor who files first. This change will be effective on March 16, 2013.

In enacting the AIA, Congress redefined what constitutes “prior art.” Generally speaking, prior art comprises printed publications and public uses relative to a critical date. Under the current system, the critical date is an inventor’s date of invention and the prior art comprises printed publications and public uses that publish or occur before the inventor’s date of invention. Under the AIA, the critical date is the filing date of a patent application. That is, under the AIA, prior art comprises printed publications and public uses that publish or occur before the patent application is filed. Prior art is important, because it is a consideration in determining whether a patent should be granted.

This change in the critical date will likely make it more difficult for an inventor to obtain a patent on an invention since the prior art will include events and publications that occur after an inventor’s date of invention. For example, suppose inventor A invents a new product on January 1, 2012 and files a patent application on July 1, 2012. Suppose further that a competitor independently invents the product and publishes the product in a trade magazine on June 1, 2012. Under the current system the trade magazine is not prior art since the trade magazine published after the inventor’s date of invention. Under the AIA, however, the trade magazine is considered prior art since it published before the patent application was filed. Thus, under the current system, a patent may be granted despite the invention being published in the trade magazine before inventor A filed his/her patent application whereas, under the AIA, the patent may be denied.

Because the United States patent system will move from a first-to-invent system to a first-to-file system on March 16, 2013, inventors and applicants who wish to take advantage of the current system must file their applications before the March 16, 2013 deadline. Otherwise, applications filed on March 16, 2013, or later, will be subject the new rules under the AIA.

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